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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,843	05/15/2006	Luke Alphey	138-05	5995
23713 7590 06/09/2009 GREENLEE WINNER AND SULLIVAN P C 4875 PEARL EAST CIRCLE SUITE 200 BOULDER, CO 80301				
EXAMINER				
KETTER, JAMES S				
ART UNIT		PAPER NUMBER		
1636				
MAIL DATE		DELIVERY MODE		
06/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/562,843

Applicant(s)

ALPHEY, LUKE

Examiner

James S. Ketter

Art Unit

1636

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 19-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,8,10,19,20,22-26 and 32 is/are rejected.
- 7) ☒ Claim(s) 2-5,7,9,11-13,21 and 27-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Upon reconsideration, a rejection based upon the reference to Amutan et al. is presented below. The delay in presentation of this rejection is regretted.

Claims 2-5, 7, 9, 11-13, 21 and 27-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 8, 10, 19, 20, 22-26 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Amutan et al. (cited as reference 4 on the IDS filed 30 November 2006).

Claim 1 is drawn to a transposable element comprising at least four inverted repeats, forming at least two pairs of opposing pairs of inverted repeats, the element comprising DNA for insertion into a host genome, the DNA being located between two pairs of opposing repeats such that excision by a transposase or transposases of said pairs, in situ, is effective to be able to leave said DNA integrated into the host genome, without the presence of said repeats flanking said DNA insertion. Claim 6 specifies within claim 1 that the element has four inverted repeats. Claim 8 specifies within claim 1 that said pairs of homologous inverted repeats are heterologous

to other pairs of inverted repeats. Claim 10 specifies that the transposable element of claim 1 comprises at least one genetic marker. Claim 19 specifies that the transposable element of claim 10 comprises at least one genetic marker associated with an identifiable step in the transposition/excision process. Claim 20 specifies within claim 19 that the marker is associated with the DNA for insertion into a host genome. Claim 22 specifies within claim 1 that the element is a class II transposable element. Claim 23 specifies within claim 1 that the transposase is encoded within the transposon. Claim 24 is drawn to a method for transforming an organism, comprising exposing replicative tissue of the organism to an element of claim 1 under conditions effective to incorporate the element into the genome thereof and, subsequently or simultaneously therewith, providing conditions suitable to excise a transposon said repeats from the genome, and selecting an organism, or tissue therefor, comprising the DNA intended for insertion lacking repeats in at least one orientation. Claim 25 specifies within claim 24 that the transformant organism is exposed to a source of active transposase. Claim 26 specifies within claim 25 that the source of active transposase comprises a helper plasmid or RNA encoding the transposase, or a transposase protein or integrated transposase source. Claim 32 specifies that the transposable element of claim 1 is effective to be able to leave said DNA integrated into the host genome without the presence of any transposon DNA.

Amutan et al. shows, e.g., at Figure 9, an element comprising two sets of inverted repeats, of two different transposons, with a small segment of DNA linking them. At the paragraph bridging pages 4 and 5, a method of using this element in a transposition process is taught. Upon excision of the two transposons, the small segment of DNA between them would remain in the chromosome.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Ketter whose telephone number is 571-272-0770. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSK
9 June 2009

/James S. Ketter/
Primary Examiner, Art Unit 1636